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10/088,328	08/29/2002	Mark Van Roon	5035-118US	2892

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EXAMINER

COLBERT, ELLA

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3696

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/088,328	Applicant(s) VAN ROON ET AL.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008 and 06 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9 are pending. Group I, Claims 1-7 have been elected and claims 8 and 9 have been withdrawn with traverse in response to the Election/Restriction requirement filed 5/06/08. The response to Applicant's traversal will be addressed below in the section of this communication entitled "Response to Applicant's Arguments with Traversal". Claims 1-7 will be examined on the merit as set forth here below.
2. The Drawings submitted 1/04/08 still remain objected to as set forth here below.

Drawings

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

The drawings are objected to because Fig. 8 has the shading too dark and under "Payee Country 1-GBP" and "Payee Country 2-USD" is not legible in the box on each side in the drawing figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as

“amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 6 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous (parent) claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 recites “A computer server programmed ...”. Claim 6 is not in agreement with the preamble of independent claim 5. The claim limitation should recite “The computer program in which a computer server is programmed with the computer program”. Claim 7 has a similar problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 and claims 2-4 which depend there from are rejected under 35

U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent (Diamond v. Diehr, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70

(1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit

decisions, § 101 process must (1) be tied to another statutory class (such as a particular

apparatus) or (2) transform underlying subject matter (such as an article or materials) to

a different state or thing (the Supreme Court recognized that this test is not necessarily

fixed or permanent and may evolve with technological advances. Gottschalk v. Benson,

409 U.S. 63, 71 (1972).

If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by “Finance: Wired for Money” by Adkins. Lynn W.

Claim 1. Adkins discloses, A method of multi-currency funds settlement as implemented by one or more computers, each running a computer program comprising computer-readable program code stored on a computer readable medium, said computer-readable program code performing comprising the following steps:

(i) transferring funds in a currency X of a first legal person who is situated in country X to satisfy in whole or part the currency X payment obligations of a second legal person, situated in a different country Y (Pg. 3, Para.2 and Para. 4); (ii) transferring funds in a currency Y of that the second legal person situated in country Y in whole or part within country Y to satisfy in whole or part the currency Y payment obligations of a legal person, who may be the first legal person or one or more different or additional legal persons (Pg. 3, Para. 3 and Para. 8-Pg. 4, Para. 3).

The “country” and “currency” and “person” are given very little patentable weight because they are considered “non functional descriptive material that cannot render nonobvious an invention that would have otherwise been obvious”. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ 2d, 1862, 1864 (Fed. Cir. 2004). *In re Gulak*, 703 F.2d 1381, 1385, 217 USPQ401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Statements of intended use do not serve to

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distinguish structure over the prior art. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 4778 F.2d 958, 959, 152 USPQ 235, 238 (CCPA 1967).

MPEP 2106.01 recites "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." "Functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Claim 2. Adkins discloses, The method as defined in Claim 1 in which each legal person seeking to transfer foreign currency enters into a computer program an amount of foreign currency required and an applicable payee (Pg. Para. 8-Pg. 4, Para. 3).

Claim 5. Adkins discloses, A computer program embodied on a computer readable medium and being executed by a computer, the computer program including computer-readable program code that receives receiving data defining the non-domestic payment obligations of parties located in two or more countries and programmed identifying opportunities to satisfy those non-domestic payment obligations by assigning payment obligations, said computer-readable program code comprising: (i) computer-readable program code that transfers funds in a currency X of a first legal person who is situated

in country X in whole or part within country X to satisfy in whole or part the currency X payment obligations of a second legal person, situated in a different country Y (Pg. 3, Para. 2 and Para. 4); and (ii) computer-readable program code that transfers funds in a currency Y of that the second legal person situated in country Y in whole or part within country Y to satisfy in whole or part the currency Y payment obligations of a legal person, who may be the first legal person or one or more different or additional legal persons (Pg. 3, Para. 3 and Para. 8-Pg. 4, Para. 3). This independent claim is rejected for the similar rationale as given above in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Finance: Wired for Money” by Adkins. Lynn W., hereafter Adkins in view of (US 6,205,433) Boesch et al, hereafter Boesch.

Claim 3. Adkins failed to disclose, The method of as defined in Claim 2 in which the computer program is hosted on one or more web servers. Boesch discloses, The method of as defined in Claim 2 in which the computer program is hosted on one or more web servers (col. 3, line 60-col. 4, line 19 and Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate

the teachings of Boesch in Adkins because such an incorporation would allow Adkins to process transactions between two users by a server.

Claim 4. Adkins failed to disclose, The method of claim 3 in which funds which are transferred to a first payee in a given jurisdiction are generated from a series of debits and credits pertaining to a debit of cleared funds of a bank account held by a legal person in said given jurisdiction, that wherein the legal person is not seeking to transfer funds to said first payee but to a second payee in a different jurisdiction. Boesch discloses, The method of claim 3 in which funds which are transferred to a first payee in a given jurisdiction are generated from a series of debits and credits pertaining to a debit of cleared funds of a bank account held by a legal person in said given jurisdiction, that wherein the legal person is not seeking to transfer funds to said first payee but to a second payee in a different jurisdiction (col. 10, lines 11-51).). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Boesch in Adkins because such an incorporation would allow Adkins to have the customer account and merchant account to be debit and credit accounts with the customer account being a debit account and the merchant account being a credit account.

Claim 6. Adkins failed to disclose, A computer server programmed with the computer program of Claim 5. Boesch discloses, A computer server programmed with the computer program of Claim 5 (col. 3, line 60-col. 4, line 19 and Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Boesch in Adkins because such an incorporation would

allow Adkins to process transactions between two users by a server.

Claim 7. Adkins failed to disclose, A computer terminal acting as a client, in which the client accepts from a party a foreign exchange requirement and sends that requirement to a server as defined in Claim 6. Boesch discloses, A computer terminal acting as a client, in which the client accepts from a party a foreign exchange requirement and sends that requirement to a server as defined in Claim 6 (col. 8, lines 22-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Boesch in Adkins because such an incorporation would allow Adkins to receive an amount in the first currency and the product price in the second currency which includes a rate of exchange at the amount in the first currency which can be converted into a converted amount in the second currency by using a server. A server by definition is a computer that provides services to another computer (called the client). See col. 10, line 61-col. 11, line 12 and line 63-col. 12, line 57 in Boesch.

Response To Applicant's Arguments with Traversal

Applicant's election with traverse of Claims 1-7 in the reply filed on 05/06/08 is acknowledged. The traversal is on the ground(s) that the examination of the allegedly distinct inventions in a single application would not create a serious burden on the Examiner. This is not found persuasive because Claims 1-7 are drawn to a method and a computer program for transferring funds in a currency X to a first legal person and transferring funds in a currency Y to the second legal person, classified in class 705, subclass 35. Claims 8 and 9, drawn to a computer based system operable such that

parties located in two or more jurisdictions meet their foreign currency payment obligations, the first party located in a first jurisdiction inputs details of a potential first foreign currency transaction, a second party located in a second jurisdiction inputs details of a potential second financial transaction, and determining if any transfer of funds from the first party to a payee located in the first jurisdiction satisfies in whole or part the requirement of the second party to transfer funds to the payee, classified in class 705, subclass 39.

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I has method for the transferring of funds in a currency of a first legal person and the transferring of funds in a currency of the second legal person and Invention II has a computer based system operable such that parties located in two or more jurisdictions meet their foreign currency payment obligations, the first party located in a first jurisdiction inputs details of a potential first foreign currency transaction, a second party located in a second jurisdiction inputs details of a potential second financial transaction, and determining if any transfer of funds from the first party to a payee located in the first jurisdiction satisfies in whole or part the requirement of the second party to transfer funds to the payee. The subcombination has separate utility such as Invention I can be used for funds transfer not only to a person in the United States to a person in a foreign country but from one state to another in the United States .or one country to another overseas and Invention II has separate utility such as any transaction involving a party in a first jurisdiction and

a party in a second jurisdiction and the transferring of funds from one jurisdiction to another jurisdiction.

The requirement is still deemed proper and therefore made FINAL.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"News Releases in 1998: A multi-language, multi-currency ready integrated business package "A.S.I.A. Ver.2.5" will be on the market supporting consolidated accounting operations by MUCOs meeting international accounting standards" disclosed an alternative solution for international accounting.

Hawkins et al (US 6,247,000) disclosed the settlement of financial transactions matching.

Earle (US 5,262,942) disclosed a financial transaction network.

Potter et al (US 5,787,402) disclosed transactions involving foreign currencies.

Doggett et al (US 5,677,955) disclosed electronics funds transfer from an account of a payer in a funds-holding institution to a payee.

Rosen (US 5,978,485) disclosed a foreign exchange transaction system.

Heinzle et al (US 6,199,046) disclosed performing real time currency conversion.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.

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The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

August 19, 2008